

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-4, 6-7, and 9-19 and 22-27 are pending in the application. Independent claim 1 has been amended to include a limitation of claim 4. Independent claim 15 has been amended to include a similar limitation of claim 11. Claims 1, 4, 11-12 and 23 have been revised to better define the claimed invention. New claims 24-27 including one or more limitations of claim 23, 16, 4 and 11, respectively, have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 112, *second paragraph* rejection of claim 23 is noted. Although Applicants do not necessarily agree with the Examiner's position, amendments have nevertheless been made to remove the claim wording at issue from claim 23. The rejection is therefore believed overcome.

The essentially repeated 35 U.S.C. 103(a) rejections of all claims are also noted. Applicants respectfully traverse the rejections because the applied references singly or in combination fail to teach or suggest all limitations of the rejected claims.

Specifically, with respect to **independent claim 15**, the Examiner argued that (i) it would have been obvious to substitute the directly attached arm of *Syndikus* for the pivoting means of *Blenke* to provide better control over the oscillating movement of the guide means and that (ii) the combination would result in a an oscillating arm that does not require additional translational movement. Applicants respectfully disagree with the Examiner's on both counts.

With respect to (i), Applicants have carefully reviewed the *Syndikus* reference yet failed to locate any teaching or suggestion that the control of *Syndikus* would be better than what is disclosed by *Blenke*. Therefore, Applicants are not convinced that a person of ordinary skill in the art would

have been motivated to combine the references in the manner proposed by the Examiner to obtain better control, because *Syndikus* does not teach or suggest such.

With respect to (ii), Applicants respectfully submit that the *Blenke* reference teaches away¹ from the Examiner's combination, because additional translational movement that the Examiner's combination would no longer require is a must-have in the reference of *Blenke*. Specifically, *Blenke* teaches away from an oscillating structure with a single elongated arm as taught by *Syndikus*. The reason, as stated in column 1 lines 40-46 of the *Blenke* reference is to avoid oscillations of great magnitude. This is the reason why the swinging mechanism of *Blenke* should be placed on moveable guides 44/46 and produce oscillations of a relatively short radius (arrow 86, about center 84 in FIG. 2B of *Blenke*). See, also *Blenke* at column 7 lines 61-65. To replace the *Blenke* moveable, short-arm, small swinging magnitude structure with the fixed, elongated arm, large swinging magnitude structure of *Syndikus* as suggested by the Examiner would run counter to the *Blenke*'s requirement for small swinging magnitude and impermissibly change the operational principle of the reference being modified, i.e., *Blenke*.²

Accordingly, Applicants respectfully submit that (i) the Examiner's motivation to combine the reference is inadequate as being evidentially unsupported, and that (ii) the *Blenke* reference teaches away from the proposed combination. The obviousness rejection of claim 15 is therefore improper and should be withdrawn.

The obviousness rejection of independent **claim 1** should also be withdrawn for at least the reasons presented above with respect to independent claim 15.

Still with respect to independent claim 1, the Examiner's reliance on *Herrmann* for the claimed horizontal arrangement of the arm is noted. The Examiner, citing *In re Japikse*, further

¹ It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). *MPEP*, section 2145.X.D.2.

² If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810,

argued that the proposed combination of *Blenke/Syndikus* with *Herrmann* is proper as it would not have changed the operation of the *Blenke* device. Applicants respectfully disagree, because *Blenke* specifically requires the guides 44/46 to be maintained in the vertical orientation or perpendicular to the curvilinear paths 26 and 28, to ensure that the spacing between the elastic strands 22 remains substantially constant after they have been secured to the substrate 24. See, for example, *Blenke* at column 8 lines 36-41 and 50-55. To rotate the *Blenke* device 90 degrees sideways as proposed by the Examiner in accordance with *Herrmann* would result in the *Blenke* guides 44/46 being oriented parallel to the curvilinear paths 26 and 28 and would defeat the intended purpose of the *Blenke* vertical arrangement of guides 44/46.³ Therefore, no person of ordinary skill in the art would have found it obvious to re-arrange the *Blenke* vertical structure in the horizontal plane as argued by the Examiner.

The obviousness rejection of claim 1 is therefore improper and should be withdrawn.

The dependent claims are considered patentable at least for the reasons advanced with respect to the respective independent claims.

As to **claims 4 and 11**, Applicants respectfully disagree with the Examiner's position that it would have been obvious to use the sheet material of *Uchida* (see Title of *Uchida* for example) in the arms of *Blenke*, *Syndikus* or *Herrmann*. The structural requirements of the *Uchida* sheet material and the remaining references' arms are quite different, and there is no reasonable expectation that the references can be successfully combined.⁴ Independent claims 1 and 15 have been amended to include some limitations of claims 4 and 11, and therefore are patentable also for the reasons presented immediately above with respect to claims 4 and 11, respectively.

¹ 23 USPQ 349 (CCPA 1959) MPEP, section 2143.01.VI.

³ If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP, section 2143.01.V.

⁴ The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). MPEP, section 2143.02.

As to **claim 18**, Applicants do not agree with the Examiner's repeated position that column 4 lines 2-4 of *Blenke* teaches that the "stretching ratio of the elastic members fed by one guiding mechanism is different from that of the elastic members fed by the other guiding mechanism." The cited portion discloses at best, and if at all, only that the patterns, rather than stretching ratios, of the elastics 26 and 28 in *Blenke* may be different. The obviousness rejection of claim 18 is therefore improper and should be withdrawn.

As to **claims 22 and 23**, the Examiner has not shown that the claim feature, i.e., weight, specific gravity, bending modulus and length, are art-recognized result effective variables.⁵ Therefore, Applicants are not convinced that the claimed ranges would have been discoverable through routine experimentation as alleged in the Office Action.

As to new **claim 24**, since the art as applied by the Examiner does not teach or suggest the claimed features of claim 23 from which claim 24 depends, there is no reasonable expectation that the Examiner's combination of the references would be able to meet the high angular acceleration as claimed.

As to new **claims 26-27**, the applied references, especially *Uchida*, do not appear to teach or suggest the claimed arm made of thermosetting synthetic resin. *Uchida* discloses only thermoplastic resin throughout the reference.

Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

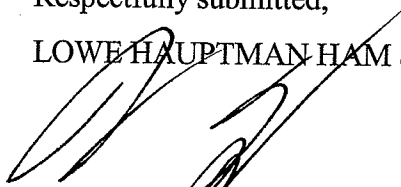
The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

⁵ "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (emphasis added) discussed in *MPEP* section 2144.05.II.B.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP



Benjamin J. Hauptman
Registration No. 29,310

USPTO Customer No. 22429
1700 Diagonal Road, Suite 310
Alexandria, VA 22314
(703) 684-1111
(703) 518-5499 Facsimile
Date: February 21, 2008
BJH/KL/mps